



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,919	12/21/2000	Thomas R. Bayerl	Sprint 1501 (4000-02700)	6827

7590

09/05/2003

Steven J. Funk
Sprint Law Department
8140 Ward Parkway
Kansas City, MO 64114

EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
----------	--------------

2181

DATE MAILED: 09/05/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,919

Applicant(s)

BAYERL ET AL.

Examiner

Khanh Dang

Art Unit

2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

In the specification, page 4, the status of US Application No. 09/226,575 must be updated.

Claim Rejections - 35 USC § 112

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, it is unclear what the phrase "chip select signal" may refer to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by McClear et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure/step that differs from McClear et al. With regard to claims 5 and 11, McClear et al. discloses an apparatus

Art Unit: 2181

for preventing contention on a data bus connecting a central processing unit and a peripheral device when the central processing unit calls for a read operation followed by a write operation, comprising: a transceiver (83, for example) with bus hold circuitry (see at least Fig. 3) connected between the data bus input/output connections of the central processing unit and the peripheral (a typical PCI bus of McClear et al.), and control logic (174/ASIC 85, for example) having an input for receiving a CPU chip select signal and an output for providing a peripheral control signal which ends at a preselected time (predetermined time) before the end of the read operation (see at least Fig. 2 and description thereof), the control logic output connected to a control input of the peripheral and to the output enable input of the transceiver (see at least Figs. 2 and 3, and description thereof). With regard to claim 6 (as best understood), McClear et al. discloses a buffer (shown generally at 0-N Fig. 5; see also Fig. 3, particularly) connected between an address output of said central processing unit and an address input of said peripheral device, said buffer having an output enable input connected to a chip select signal. With regard to claim 7, the preselected time (predetermined time) is equal to or greater than the maximum time to enable high impedance state of said transceiver. In another word, active output will remain for a predetermined time period before returning to a tri-state or high impedance state. With regard to claims 1-3, and 9, it is clear that one using the apparatus of McClear et al. would have performed the same step set forth in claims 1-3, and 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClear et al.


McClear et al., as explained above, discloses the claimed invention including the preselected time (predetermined time period). However, McClear et al. does not specifically disclose that the preselected time (predetermined time period) is greater than 50 nanoseconds. It would have been obvious to one of ordinary skill in the art at the time the invention was made to set the preselected time greater than 50 nanoseconds for the predetermined time of McClear et al., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges (greater than 50 nanoseconds) involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It has also been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F2d 272, 205 USPQ 215 (CCPA 1980).

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClear et al.

McClearn et al., as explained above, discloses the claimed invention. However, McClearn et al. does not specifically disclose various clock cycles for Read and for ending Read. It would have been obvious to one of ordinary skill in the art at the time the invention was made to set an appropriate clock cycles for the system of McClearn et al., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F2d 272, 205 USPQ 215 (CCPA 1980).

U.S. Patent Nos. 5,768,550 to Dean et al. and 5,634,034 to Foster are cited as relevant art.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang
Primary Examiner